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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,355	11/08/2001	James Travis	235.00440101	4382

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EXAMINER

SWOPE, SHERIDAN

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 08/29/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/008,355

Applicant(s)

TRAVIS ET AL.

Examiner

Sheridan L. Swope

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, and 19-22 drawn to dipeptidylpeptidase proteins, classified in class 435, subclass 212.
- II. Claims 10-13, drawn to dipeptidylpeptidase DNA classified in class 536, subclass 223.2.
- III. Claim 14, drawn to method of identifying an inhibitor of dipeptidylpeptidase, classified in class 435, subclass 24.
- IV. Claims 15 and 16, drawn to a method of inhibiting the growth of a bacterium, classified in class 424, subclass 115.
- V. Claims 17 and 18, drawn to a method of protecting against periodontal disease, classified in class 424, subclass 49.
- VI. Claim 23, drawn to an inhibitor of dipeptidylpeptidase. Classification unknown as the specification discloses no structural information for the claimed compound. Possible classification could be class 260 (organic compounds), class 530 (proteins), class 536 (carbohydrates), class 423 (inorganic compounds) etc.

These inventions are distinct, each from the other, because of the following reasons.

The nucleic acids of Invention II are related to the protein of Invention I by virtue of encoding the same. The DNA molecule has utility for the recombinant production of the protein in host cells. Although the DNA molecule and protein are related since the DNA encodes the specifically claimed protein, they are distinct inventions because they are physically and

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functionally distinct chemical entities, and because the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. In addition, the DNA may be used for processes other than the production of the protein, such as nucleic acid hybridization assays.

The protein of Invention I, the DNA of Invention II, and the inhibitor of Invention VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, products of Inventions I, II, and VI are different inventions because they are physically and functionally distinct chemical entities.

The methods of Inventions III, IV, and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The methods of Inventions III, IV, and V to identify an inhibitor of dipeptidylpeptidase, inhibit the growth of bacterium, and protect against periodontal disease, respectively, are independent as they can comprise different steps, utilize different products and/or produce different results.

The protein of Invention I is unrelated to the method of inhibiting bacterium of Invention IV and the method of protecting against periodontal disease of Invention V. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the methods of Inventions IV and V can neither use the product of Invention I nor be used to make said product.

The DNA of Invention II is unrelated to the method of identifying an inhibitor of Invention III, the method of inhibiting bacterium of Invention IV, and the method of protecting against periodontal disease of Invention V. These inventions are unrelated because, the methods of Inventions III, IV, and V can neither use the product of Invention I nor be used to make said product.

The inhibitor of Invention VI is related to the method of identifying an inhibitor of Invention III as product and process of using. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the inhibitor can also be used for purification of the enzyme while the method can use any compound to test for inhibition.

The protein of Invention I and the method of identifying inhibitors of Invention III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein of Invention I can be used for production of an antibody, for the study of its enzymatic properties, and as a pharmaceutical agent in its own right.

The inhibitor of Invention VI and the method of inhibiting the growth of bacterium of Invention VI are related as product and process of use. These inventions are distinct because, the inhibitor of Invention VI can be used as starting material for production of another compound while, inhibiting the growth of bacterium can also be practiced by boiling the cells.

The inhibitor of Invention VI and the method of protecting against periodontal disease of Invention V are related as product and process of use. These inventions are unrelated because, the inhibitor of Invention VI can be used as starting material for production of another compound while, protecting against periodontal disease can be practiced by flossing.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art due to their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Invention I: For Claim 6, dipeptidylpeptidases of the following species are claimed:

1. SEQ ID NO: 3
2. SEQ ID NO: 18
3. SEQ ID NO: 19
4. SEQ ID NO: 20
5. SEQ ID NO: 21
6. SEQ ID NO: 22
7. SEQ ID NO: 23
8. SEQ ID NO: 24
9. SEQ ID NO: 25
10. SEQ ID NO: 26

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally

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held to be allowable. Currently, Claims 1, 3, 6, 19, and 20 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

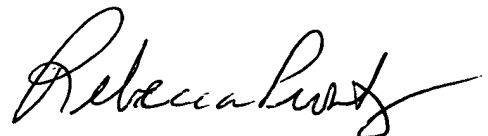
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 703-305-1696.

The examiner can normally be reached on M-F; 8:30-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
**REBECCA E. PROUTY**  
**PRIMARY EXAMINER**  
**GROUP 1800**  
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